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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,839	03/16/2001	Ronald N. Perry		7082

7590 07/15/2003

Patent Department  
Mitsubishi Electric Research Laboratories, Inc.  
201 Broadway  
Cambridge, MA 02139

EXAMINER

WALLACE, SCOTT A

ART UNIT	PAPER NUMBER
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2671

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/810,839

Applicant(s)

PERRY ET AL.

Examiner

Scott Wallace

Art Unit

2671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Response to Arguments***

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12 of copending Application No. 09/810,261.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to remove an element and its function to make it broader as cited by In re Nelson (CCPA) 95 USPQ 82.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-2 and 6 of copending Application No. 09/809,682. Although

**Art Unit: 2671**

the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to remove an element and its function to make it broader as cited by In re Nelson (CCPA) 95 USPQ 82.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

5. Claims 2-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Scott Wallace** whose telephone number is **703-605-5163**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mark Zimmerman**, can be reached at 703-305-9798.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**


**Application/Control Number: 09/810,839**

**Page 4**

**Art Unit: 2671**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA,  
Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be  
directed to the Technology Center 2600 Customer Service Office whose telephone number is  
(703) 306-0377.



MARK ZIMMERMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

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**FULL TEXT OF CASES (USPQ FIRST SERIES)**

In re Nelson, 95 USPQ 82 (CCPA 1952)

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**In re Nelson**

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**(CCPA)**

**95 USPO 82**

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**Decided June 24, 1952**

**Rehearing denied Sept. 30, 1952**

**Appl. No. 5862**

**U.S. Court of Customs and Patent Appeals**

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**Headnotes**

**PATENTS**

**1. Patentability-Adding or subtracting parts**

Number of component parts remaining in device has no bearing on application of rule that, if omission of element is attended by corresponding omission of function performed thereby, there is no invention if elements retained perform same functions as before.

**2. Patentability-Invention-In general**

Improvement of prior art structures is insufficient to warrant patent if there is absence of invention.

**3. Patentability-Adding or subtracting parts**

Ordinarily, application of reenforcing parts to a structure does not involve invention; conversely, ordinarily, there is no invention in omitting unnecessary reenforcing device.

**4. Patentability-Adding or subtracting parts**

Omission of reenforcement results in saving of cost, material, and weight, without loss of strength, but this is insufficient to bring claims into patentable category.

**5. Patentability-Anticipation - United States patents**

That prior patent is more than 26 years old, standing by itself, is no reason why it cannot be invoked as reference if structure is clearly and definitely shown.

**Particular patents-Containers**

Nelson, Shipping Containers and Method of Manufacture, claims 6, 14, and 16 of application refused.

### **Case History and Disposition:**

Page 83

Appeal from Board of Appeals of the Patent Office.

Application for patent of Theodore J. Nelson, Serial No. 652,370, filed Mar. 6, 1946; Patent Office Division 40. From decision rejecting claims 6, 14, and 16, applicant appeals. Affirmed; Johnson, Judge, dissenting with opinion in which O'Connell, Judge, concurs.

#### **Attorneys:**

William H. Atkinson, San Francisco, Calif. (Lloyd W. Patch, Washington, D. C., of counsel) for appellant.

E. L. Reynolds (H. S. Miller of counsel) for Commissioner of Patents.

### **Opinion Text**

#### **Opinion By:**

Worley, Judge.

Appellant has appealed here from a decision of the Board of Appeals of the United States Patent Office finally rejecting as unpatentable over the prior art three claims of an application alleging new and useful improvements in "Shipping Containers and Method of Manufacture." The application was filed March 6, 1946, serial No. 652,370.

The rejected claims read as follows:

6. A blank for the manufacture of corrugated fibre board containers, comprising a wide rectangular sheet of multi-ply corrugated board having an intermediate corrugated ply, and outer facing applied throughout the entire area of said corrugated ply, a narrower inner facing extending longitudinally and centrally of said corrugated ply and of sufficient width to encompass the fold lines of a finished container, and fold forming score lines and cuts upon said multi-ply board within the limits of said inner facing, whereby the walls of the container will be of double faced construction and the closure flaps thereof will be substantially of single faced construction.

14. In a multi-ply fibre board shipping case, the improvement which consists in forming the shipping case of a single sheet of double faced corrugated board, leaving part of the closure flap areas incomplete as to the inner facing component thereof, and disposing the closure flap areas so that when the flaps of the case are closed and glued the over-lapping areas will complete at least one of the incomplete flap facing components of each pair.

16. A fibre board shipping container comprising, a rectangular box-like container constructed from a single blank of fibre board having a central portion which forms the sides and ends and fold lines of double faced corrugated fibre board and other portions which form the top and bottom closure flaps of single faced fibre board, and characterized by the fact that, when closed and glued said closure flaps will cooperate with each other and provide the equivalent of a double faced corrugated board with a corrugated lining at the top and bottom of the container.

The cited prior art consists of the following patents:

J. C. Bulis 1,555,182 September 29, 1925.

E. E. Maston, 1,588,123 June 8, 1926.

The claimed invention relates to shipping containers fabricated from multi-ply corrugated fiber board. As the board is constructed it contains a middle layer of corrugated cardboard to which is glued an outer facing sheet of paper covering its entire area. The other side of the cardboard has glued to it a like facing sheet of paper that is of reduced width. That facing, when glued to the cardboard, extends at right angles to the corrugations and is only wide enough to encompass the fold line of the blank when folded to complete the container. The entire board is made as a continuous strip and then suitably cut and scored to provide a blank from which is made the finished container. The flap-forming portions of the container are of two-ply construction by reason of the reduced width of the inner paper facing. That construction exposes the corrugated ply inwardly. When the flaps are folded they overlap in pairs on the top and bottom of the completed structure and when glued the flaps cooperate with each other so that the outer facing of the inner flaps provide the equivalent of a 3-ply top and bottom with an additional ply of corrugated board as a padding at those points. It is alleged in the application that a container so

Page 84

made is lighter in weight and cheaper to make than other containers of the same size and that this result is obtained without loss of strength in the use of the containers.

The Bulis patent relates to a packing box generally similar to that defined in the involved claims. The patent discloses that the packing box is made of corrugated paper between layers of smooth paper which is secured to the faces of the corrugated paper. The object of the invention is to "provide a simple means for reenforcing the top and bottom edges where the flaps bend \* \* \*." That object is said to be accomplished by means of three strips of paper which cover the corrugated layer and having edge portions which overlap.

The patent to Maston relates to a bottle wrapper. It discloses a wrapper made of corrugated board which is faced on one side with paper. Portions of the corrugated layer and the end-forming portions thereof are omitted.

The Primary Examiner rejected the claims on appeal as unpatentable over the Bulis patent or that patent in view of the Maston reference.

In discussing the Bulis patent, the examiner noted that the three overlapping sheets of paper in that patent are in the areas of the closure flap fold lines and thus provide reenforced construction at such lines. He was of the opinion that to omit the two outside facing strips of the Bulis device, which function in providing a reenforced fold line and their inherent function of reenforcing the closure flaps, would lack invention. He held that such omission would not result in any unobvious or unexpected advantage because such advantage would be inherent.



In discussing the Maston patent, the examiner stated that it is broadly old, as shown in the structure of that reference, to reduce the bulk weight of a container by omitting portions of the inner thickness and because of such understanding, he was of the opinion that it would be obvious to leave out the two outside paper-facing strips of the Bulis device for the same purpose.

The Board of Appeals agreed with the reasoning of the examiner and his conclusion for the reason that it did not believe that the omission of the two outer paper strips of the Bulis structure would cause the other elements of the device to function differently from those which they normally would perform if the strips were present in that container. The board asserted that appellant was unable to point out any such functions or attribute any new or unobvious results to such omission.

[1] The board noted it is well established that if the omission of an element is attended by a corresponding omission of the function performed thereby, there is no invention if the elements retained perform the same functions as before. In re Trester, 391 O.G. 501, 1930 C.D. 54 [ 3 USPQ 312 ]; In re Collins, 408 O.G. 5, 1931 C.D. 247 [ 8 USPQ 308 ]; In re Fry, 417 O.G. 850, 1932 C.D. 165 [ 12 USPQ 1 ]; In re Fischer, 422 O.G. 905, 1932 C.D. 455 [ 13 USPQ 389 ]; In re Porter, 444 O.G. 991, 1934 C.D. 278 [ 20 USPQ 298 ].

The board, in its decision, stated that the rejection of the claims as unpatentable over the Bulis patent in view of Maston appeared to be cumulative and, therefore, it was not deemed necessary to consider such rejection.

It is conceded by counsel for appellant that "if applicant had omitted only the overlapping or reenforcing function of the strips 4 and 5 of Bulis, the examiner's reasoning would appear to be sound \* \* \*."

Counsel for appellant agree as to the correctness of the rule with respect to the omission of an element and its corresponding function but in their brief argue that in the present instance it is believed a distinction can be made as the device here claimed involves only a single element, namely, "a flat foldable blank from which a carton \* \* \* may be formed."

In the structure of the Bulis patent, and with respect to the omission of the two outer strips, we are unable to see that the number of component parts remaining in the device of that patent, or the number which appellant claims, can have any bearing on the application of the rule set out in the cases which are cited by the board.

[2] It may well be that appellant has made an improvement over similar structures as shown by the prior art. However, as this court stated in the case of In re John B. Burnham, 19 C. C. P. A. (Patents) 725, 53 F.2d 534, 11 USPQ 134 , that is not sufficient to warrant a granting of the patent if there is absence of invention.

In our opinion, no invention is here involved. In view of the prior art it would require no more than the skill of the ordinary mechanic to produce a structure such as is shown in the claims. In re Cady, 27 C. C. P. A. (Patents) 1208, 111 F.2d 899, 45 USPQ 576 .

[3] Ordinarily, the application of reenforcing parts to a structure does not involve invention. In re George E. Campbell, 18 C.C.P.A. (Patents) 1351, 48 F.2d 915, 9 USPQ 189 . As was pointed out by the solicitor in his brief, it may well be that strength in a device is a

matter of degree and the amount of strength needed in a given place is usually obvious to the skilled worker in the art.

It is argued in the brief of the solicitor that the converse of that statement should be equally true and for the same reason. In other words, ordinarily there would be no invention in omitting a reenforcing device when it is seen not to be necessary.

The patent to Bulis discloses the outside strip-reenforcing devices. Surely it would not involve invention if appellant or anyone else discovered that the device of that patent is sufficiently strong without the reenforcing parts.

[4] It is probably true that the omission of the inner facings from the container of appellant results in a saving of cost, material, and weight, without loss in the strength of the container. That, however, is not sufficient to bring the involved claims into the patentable category. In re Belsinger, 28 C.C.P.A. (Patents) 760, 115 F.2d 820, 47 USPQ 444 .

[5] Even though the patent to Bulis is more than 26 years old, that fact standing by itself is no reason why it cannot be properly invoked as a reference if the structure disclosed and relied upon is clearly and definitely shown. In re Rosenberger, 28 C.C.P.A. (Patents) 818, 116 F.2d 507, 48 USPQ 124 ; and In re Walter I. Jones, 39 C.C.P.A. (Patents) 913, 195 F.2d 538, 93 USPQ 220.

For the reasons hereinbefore set out, the decision of the board is affirmed.

Jackson , Judge, sat during the argument of this case but retired April 1, 1952, before the opinion was fully prepared. He was recalled in conformity with Section 294 (c)(d), Title 28 U.S.C. to participate in the decision and did so.

### **Dissenting Opinion Text**

#### **Dissent By:**

Johnson, Judge, dissenting.

It is true that, *in the light of appellant's disclosure*, it would not be difficult to modify the prior art devices of record to produce a device such as that disclosed and claimed by appellant. This, however, does not necessarily negative the presence of patentable invention since the conception of a new and useful improvement must be considered along with the actual means of achieving it in order to determine the presence or absence of patentable invention. In re DeLancey, 34 C.C.P.A. (Patents) 849, 159 F.2d 737, 72 USPQ 477. Although an ordinary person skilled in the art may construct the device claimed, claims may be allowed where there is no teaching in the prior art which would have led him to do so, providing, of course, that the claimed device displays the exercise of invention. In re Riggs, 38 C.C.P.A. (Patents) 1094, 189 F.2d 285, 89 USPQ 588. It seems to me that appellant by his simple changes has indeed produced what the majority refer to as an improvement-in my opinion, a marked improvement-and I fail to find in the prior art anything that suggests the simple changes appellant has made to achieve such improvement.

I am therefore of the opinion that the claimed device is not only new and useful, but involves invention over the art of record. Accordingly, I think the decision of the Board of Appeals should be reversed.

### **Concurring/Dissenting Opinion Text**

#### **Concurrence/Dissent By:**

O'Connell, Judge, concurs in this dissent.

- End of Case -

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